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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/886,869	06/21/2001	Hong Cai	JP92000142US1 (14657)	6085

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EXAMINER	
JOO, JOSHUA	

ART UNIT	PAPER NUMBER
2154	

DATE MAILED: 03/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/886,869	CAI ET AL.	
	Examiner	Art Unit	
	Joshua Joo	2154	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *20 December 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-4* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-4* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

1. Claims 1-4 are rejected.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claim 1 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holt III, Patent #6,324,565 and in view of Shimomura et al, Patent # 6,526,580, Shimomura hereinafter.

4. As per claim 1, Holt teaches an apparatus for providing generated documents to clients. Holt's invention comprises of:

a) Network connecting unit for fetching data from backend servers and packaging the data into elements. (Holt III, Column 6, line 29-31. Data is retrieved from the content providing server.)

b) Cache for caching the elements formed by said network connecting unit by packaging. (Holt III, Column 5, line 19-23. The data used in creating the document is cached or stored in the cache.)

c) i. Controller, in response to a request for information service from a client, for fetching relevant elements from cache. (Holt III, Column 5, line 11-20. Cache software determines if the document is located in the cache, then intermediate server receives document information.)

ii. For the elements that cannot be fetched from the cache, instructing the network connecting unit to fetch corresponding data from backend servers. (Holt III, Column 5, line 54-62. The system determines whether the data needed to the make the documents are required from the cache and from the content providing server. Holt III, Column 6, line 29-31. Data is retrieved from the content providing server.)

iil. Obtaining the elements formed by the network connecting unit by packaging all the fetched elements into a document and sending it back to the

client. (Holt III, Column 6, line 41-44. Once all the data has been gathered, a document is made. Column 6, line 52-55. Once the document has been created, the document is transmitted to the client.)

5. Holt III teaches of an invention where documents for clients are generated from data obtained from the cache and the backend server to reduce network traffic. However, Holt III's invention from the claim only differs in that Holt III refers to documents but does not mention XML. Shimomura's invention discloses caching of information to form XML documents because he states it is one of the most popular methods of presenting information. XML documents do not deal with presentation but just the content itself, and sending just the content will require less bandwidth. It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the documents of Holt III into XML documents because sending XML documents will reduce the traffic being send over the network.

6. As per claim 3, Holt III teaches an apparatus for providing generated documents to clients. Holt's invention comprises of:

a) Receiving a request for information service from a device. (Holt III, Column 4, line 66-67. Server receives a document request from the client.)

b) Fetching elements which are relevant to the request for information service from a local cache. (Holt III, Column 4, line 24-28. Intermediate server has caching software and cache. Column 5, line 11-20. Cache software determines if the document is located in the cache, then intermediate server receives document information.)

c) If no relevant elements are fetched from the local cache, fetching corresponding data from backend servers, packaging the data into elements in the local cache. (Holt III, Column 6, line 26-34. If the data is not located on the intermediate server, data is received from the content providing server. Once the data is received, it is cached.)

d) Packing all the fetched elements into a document and sending it back to the device. (Column 6, line 41-55. The data is used to create a document and send to the client.)

7. Holt III teaches of an invention where documents for clients are generated from data obtained from the cache and the backend server to reduce network traffic. However, Holt III's

invention from the claim only differs in that Holt III refers to documents but does not mention XML. Shimomura's invention discloses caching of information to form XML documents because he states it is one of the most popular methods of presenting information. XML documents do not deal with presentation but just the content itself, and sending just the content will require less bandwidth. It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the documents of Holt III into XML documents because sending XML documents will reduce the traffic being sent over the network.

8. Claims 2 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holt III and Shimomura as applied to claims 1 and 3 above, and in view of Chandra et al, Patent #6,457,047, Chandra hereinafter.

9. As per claim 2 and 4, Holt III teaches of an invention where documents for clients are generated from data obtained from the cache and the backend server to reduce network traffic. However, Holt III's invention does not teach of an indexing mechanism for creating indices for all the XML elements stored in the cache. Chandra teaches an invention that has a centrally maintained table in the cache directory for determining if the query is cached. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Holt III and Chandra for the invention of Holt III to have a maintained table of the information in the cache in order to minimize time in obtaining information from the cache.

Response to Arguments

10. Applicant's arguments filed 12/20/2004 have been fully considered but they are not persuasive.

11. Applicant argued that Holt, Shimomura, and Chandra does not even remotely disclose or explain the above-noted problems with the prior art, or remotely disclose or explain the need, object, and basis and solution of the present invention.

12. In response to applicant's argument, applicant fails to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

13. Applicant argued that the examiner is using impermissible hindsight in combining the references with the knowledge of an ordinarily skilled artisan in the art at the time of the invention.

14. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

15. Applicant argued that there is no motivation to combine the Holt, Shimomura and Chandra references with any specific understanding or technological principle within the knowledge of on one of ordinary skill in the art regarding the problems addressed by the present invention.

16. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Conclusion

17. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

18. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua Joo whose telephone number is 571 272-3966 and fax number is 571 273-3966. The examiner can normally be reached on Monday to Thursday 8 to 5:30.

20. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John A Follansbee can be reached on 571 272-3964.

21. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

March 17, 2005
JJ

JOHN FOLLANSBEE
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